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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/141,964 08/28/98 MARINO

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MM91/0206

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EXAMINER

WACHSMAN, H

ART UNIT

PAPER NUMBER

2857

DATE MAILED:

02/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/141,964

Applicant(s)

Marino et al.

Examiner

HAL WACHSMAN

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7-5-00
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-16, 18-28, 30-34, 36-45, 47-63, 67, 69-76 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 18-28, 30-34, 36-45, 47-63, 67, 69-76 is/are allowed.
- ☒ Claim(s) 1-16 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☒ The drawing(s) filed on 8-28-98 is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892(2)
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The revocation of power of attorney and appointing of new power of attorney filed November 22, 1999 has not been accepted because as required by MPEP 402.10 all of the inventors did not sign this letter of power of attorney (it only has the signature of inventor Michael A. Marino Jr.). In addition, the paper was not accompanied by a petition and fee under 37 C.F.R. 1.182 giving good and sufficient reason as to why the papers should be accepted. Appropriate correction is required.
2. The Applicant's amendment filed 7-5-00 in the section entitled "IN THE CLAIMS" presented the instruction "Please cancel Claims 29 and 35...". Consequently, claims 29 and 35 have been cancelled. However, later on in this amendment on pages 6-7, the Applicant presented amended versions of claims 29 and 35 for entry. Consequently, because of the prior cancellation of claims 29 and 35, the amended versions of claims 29 and 35 could not be entered. Appropriate correction is required.
3. As was already stated in the previous Office Action, the Examiner objects to Figure 1 because Figure 1 was known in the prior art (see page 2 of specification) and consequently needs to be labeled as "PRIOR ART". **Appropriate correction is required.**

Oath/Declaration

4. As was already stated in the previous Office Action, the oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date **is required**. See MPEP §§ 602.01 and 602.02.

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The oath or declaration is defective because:

the Declaration provides for each inventor a residence address and it is not clear as to whether or not this address is both their residence and post office address or if they have a different post office address that was not cited on the declaration.

5. As was already stated in the previous Office Action, page 8, line 1, of the specification cites U.S. Patent No. 5,068,616 however the title given here is incorrect. The correct title of this patent is "Monitoring Process and Device of a Quasi-Closed Electromagnetic Shield." Page 13 cites "DESCRIPTION OF THE DRAWINGS" however this should be "BRIEF DESCRIPTION OF THE DRAWINGS". Page 20, line 3, cites "a fiber optic receiver.." in which it appears that "a" should be capitalized. **Appropriate correction is required.**

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains legal phraseology (i.e. reads like a claim "...comprising the steps of..") . The Applicant has attempted to correct the Abstract through the use of underlining and bracketing. However, these types of techniques are

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used to make **amendments to the claims** and not parts of the specification. Consequently, the placement of brackets around a word in an Abstract does not delete the word within the brackets. Therefore the words "and comprising" remain in the Abstract with brackets around it as well as an underline would appear under the word "electronic" if the application goes to issue at a future time. Appropriate correction is required. See MPEP § 608.01(b).

7. Claims 1-16, 18-28, 30-34, 36-45, 47-63, 67 and 69-76 are objected to under 37 C.F.R. 1.75(a) for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claim 1, step b, cites "the width of said wide band excitation signal" however exactly what type of width is being referred to here ? This same type of problem also occurs in claim 72, step g. Claims 18-28 refer to "The method in..". However, did the Applicant intend here to refer to "The method of.." as this was the format in the majority of the preambles of the dependent claims. In claim 24 "RF" needs to be defined. The last line of claim 30 cites "said network" which should be "said telemetry network". This same type of problem also occurs in the last 2 lines of claim 34. It appears that in claim 40, line 2, "synthesizer" should be "synthesizers". Claim 45, lines 1-2, cite "said waveform synthesizer" which should be "said one or more waveform synthesizers". The use of the pronoun "its" in claim 45, line 2, adds vagueness with respect to what "its" refers to. Claim 47 cites "said system under test" which lacks antecedent basis. Claim 48 cites "said excitation signal" which should be "said wide band excitation signal". Claim 52, parts c, d, e and g, cite "recorder/processors" which should be "recorders/processors". This same type of problem also occurs in claims 61-63, line 1. Claim 52,

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part c, cites "said system" which should be "said physical system". Claim 52, part g, lines 6-8, cite "the signals received in said physical system from said low-power, wide band input signal" which lacks clear antecedent basis. The last line of claim 52 cites "...to a transfer function" however did the Applicant intend to cite here to compute a transfer function of the physical system ? There is no period at the end of claim 53. Claim 55, line 1, cites "The method apparatus of Claim 53..." which is incorrect and should be "The apparatus of Claim 53..". Claim 60, line 2, cites "the modulated signal" which should be "the modulated excitation signal". Claim 62, lines 2-3, cite "the modulated excitation signal" which lacks antecedent basis. Claim 72, lines 11-12, cites "said wide band excitation input signals" however the antecedent basis is singular. Claim 72, step f, cites "said network" however the antecedent basis is "telemetry network". Claim 74, step b, cites "recorder/processors" which should be "recorders/processors". In claim 74, lines 9-10 and 12, it is not clear why there is a semicolon between "excitation" and "input signals". Claim 74, line 11, cites "said distributed location" which lacks clear antecedent basis. The examiner asks the applicant to better claim the limitations cited above. While the examiner understands the intentions of the applicant he feels confusion could be drawn from the limitations cited above. Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's Admissions of the prior art in view of Krayeski et al. (5,471,146).

As per claim 1, the Applicant's Admissions of the prior art (page 5, line 21, page 6, lines 1-3, 7-13, page 17 lines 18-20, page 29 all, page 30 all, page 31 lines 1-11 of the specification) discloses step b). The Applicant's Admissions of the prior art (page 5 lines 15-22, page 6 lines 1-17 of the specification and figure 2) discloses step a) with the exception of clearly disclosing the low-power aspect of the wide band input signal. However, Krayeski et al. (Col. 1 lines 14-16, col. 3 lines 43-47) teaches this excepted feature. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Krayeski et al. to the Applicant's Admissions of the prior art as specified above because as taught

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by Krayeski et al. (Col. 1 lines 14-16) new low power personal communications products such as the Motorola CT-2 System were already known in the art and in common use.

As per claim 2, the Applicant's Admissions of the prior art (page 3 lines 14-16, page 5 line 22, page 6 lines 1, 8 of the specification) discloses the feature of this claim.

As per claim 3, it would have been obvious to a person of ordinary skill in the art at the time the invention was made that frequency modulation was well known in the art and is a modulation technique in which the carrier frequency is shifted by an amount proportional to the value of the modulating signal.

As per claim 4, it would have been obvious to a person of ordinary skill in the art at the time the invention was made that amplitude modulation was well known in the art and is a method of adding information to an electronic signal in which the signal is varied by its height to impose information on it.

As per claim 5, it would have been obvious to a person of ordinary skill in the art at the time the invention was made that phase modulation was well known in the art and that in this modulation the phase of the sine wave is changed as the information to be carried is changed.

As per claim 6, it would have been obvious to a person of ordinary skill in the art at the time the invention was made that there are various electromagnetic radiation producing electrical/electronic devices in everyday use in our environment which can create an ambient signal.

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As per claim 7, the Applicant's Admissions of the prior art (page 29 all, page 30 lines 1-19 of the specification) discloses the feature of this claim.

As per claim 8, the Applicant's Admissions of the prior art (page 29 lines 3-5 of the specification) discloses the features of this claim.

As per claim 9, the Applicant's Admissions of the prior art (page 29 lines 3-5 of the specification) discloses the features of this claim.

As per claim 10, the Applicant's Admissions of the prior art (page 29 lines 3-5 of the specification) discloses the features of this claim.

As per claim 11, the Applicant's Admissions of the prior art (page 29 lines 1, 2, 5-8 page 31 lines 2-4, 6-11 of the specification) discloses the feature of this claim.

As per claim 12, the Applicant's Admissions of the prior art (page 31 lines 2-4, 9-11 of the specification) discloses the feature of this claim.

As per claim 13, the Applicant's Admissions of the prior art (page 31 lines 2-4, 6-8 of the specification) discloses the feature of this claim.

As per claim 14, the Applicant's Admissions of the prior art (page 31 lines 2-4, 6-8 of the specification) discloses the feature of this claim.

As per claim 15, the Applicant's Admissions of the prior art (page 31 lines 2-4, 6-8 of the specification) discloses the feature of this claim.

As per claim 16, the Applicant's Admissions of the prior art (page 31 lines 2-4, 6-8 of the specification) discloses the feature of this claim.

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10. Claims 18-28, 30-34, 36-45, 47-63, 67 and 69-76 are allowed subject to the appropriate correction of the 37 C.F.R. 1.75(a) objections noted above.

11. The declaration under 37 CFR 1.132 filed 7-5-00 is insufficient to overcome the rejection of claims 1-16 based upon the Applicant's Admissions of the prior art in view of Krayeski et al. (5,471,146) as set forth in the last Office action because: it is not clear what the vested interest is of Dr. Robert A. Koslover in the instant application and it is not commensurate with the full scope of the claims (such as for example the use of the stochastic process to derive the transfer function). It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. It state(s) that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references and still were unable to solve the problem. See MPEP §716.04.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

With respect to the variety of other exhibits presented by the Applicant, these exhibits refer only to the system described in the above referenced application and not to the individual

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claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims.

12. Applicant's arguments filed 7-5-00 have been fully considered but they are not persuasive with respect to claims 1-16. As a result of the Applicant's arguments and further review and consideration, all of the previous art rejections have been withdrawn with the exception of the art rejections shown above. With respect to the Krayeski et al. the Applicant argues:

“Krayeski's invention measures reflected power from an antenna within a circuit. This is a reflection measurement. While some individual components (e.g. mixers, receivers, transmitters, etc.) bear some similarity to components in the instant invention, they are:(1) not configured the same way, and (2) do not solve (or even address) the same problems as those of the claimed invention.”

However, with respect to the above the Applicant is arguing a variety of unclaimed merits or distinctions.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal Wachsman whose telephone number is (703) 305-9788. The examiner can normally be reached on Monday to Thursday from 7:00 A.M. to 4:30 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff, can be reached on (703) 308-1677.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-7722 (for informal or draft communications, please label "PROPOSED"
or "DRAFT")

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Hand-delivered responses should be brought to Crystal Plaza IV, 2201 South Clark Place,
Arlington, VA., Fourth Floor (Receptionist).

February 4, 2001

